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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,791	03/28/2000	Andrew S. Van Luchene	99-086	5835

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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/536,791

Applicant(s)

VAN LUCHENE ET AL.

Examiner

Lalita M Hamilton

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on amendment filed on March 19, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### Summary

On September 10, 2003, an Office Action was mailed to the Applicant rejecting claims 1-20. On March 19, 2004, the Applicant responded by adding new claims 21-40.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 and 20-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-16 and 20-40 are rejected under 35 U.S.C. 101 because, the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to overcome the 101 rejection above, the following preamble is suggested:

-A computer implemented method for ---, or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 7-8, 10, 12, 17-19, 21-22, 26, 28-30, 34-36, and 39-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Jagadish (6,105,860).

Jagadish discloses a method and corresponding system for billing arrangements comprising receiving an application for a financial account and an authorization to credit a first amount to the financial account, receiving information identifying a substitute collection technique, and finalizing the transaction after receipt of the application and the information (col.4, line 5 to col.4, line 17); establishing a second amount associated with the substitute collection technique (col.4, line 5 to col.4, line 17); the information identifying the substitute collection technique includes information specifying at least one of a credit account to be credited, a debit account to be credited; a financial account

Art Unit: 3624

to be credited, a store account to be credited, and an address to which payment is to be sent (col.4, line 5 to col.4, line 17); declining the application and crediting the substitute form of collection by a second amount (col.4, line 5 to col.4, line 17—credited if financial account is invalid); performing an analysis of the application and performing one of crediting the financial account by an amount equal to the first amount if the analysis indicates an approval of the application and crediting the substitute form of collection by a second amount if the analysis indicates a refusal of the application (col.4, line 5 to col.4, line 17); receiving an application for a financial account, receiving information identifying a substitute collection technique, determining a first payment amount to be paid to the first financial account if the application is approved, determining a second payment amount to be paid to the substitute collection technique if the application is rejected, and finalizing the transaction based on an approval or rejection of the application (col.4, line 5 to col.4, line 17); a processor and a storage device coupled to said processor and storing instructions adapted to be executed by said processor to receive an application for a financial account and an authorization to pay a first amount to the financial account, receive information identifying a substitute collection technique, and finalize the transaction using at least one of the financial account and the substitute collection technique (col.4, line 5 to col.4, line 17 and col.5, line 59 to col.6, line 25); storage device further stores at least one of a transaction database, a seller database, and an application database (col.4, line 5 to col.4, line 17 and col.5, line 59 to col.6, line 25); a medium storing instructions adapted to be executed by a processor to perform a method for conducting a transaction, said method comprising receiving an application

Art Unit: 3624

for a financial account and an authorization to pay a first amount to the financial account, receiving information identifying a substitute collection technique, and finalizing the transaction using at least one of the financial account and the substitute collection technique (col.4, line 5 to col.4, line 17); and the substitute form of collection comprises at least one of a credit account, a debit account, a store account, and an address to which payment is to be sent (col.4, line 5 to col.4, line 17).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-6, 9, 11, 13-14, 16, 20, 23-25, 27, 31-33, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagadish in view of Walker (5,945,653).

Jagadish discloses the invention substantially as claimed; however, Jagadish does not disclose receiving an acceptance of an incentive offer, wherein the first amount is based on the incentive offer; offering an incentive based on receipt of the application; offering an incentive based on an approval of the application; authorization includes a proxy agreement and wherein the first amount is undetermined at the time of the authorization; the second amount is equal to the first amount minus an incentive amount; the second amount is equal to the first amount less an incentive amount; the transaction is a product return transaction; or offering a seller an incentive amount.

Art Unit: 3624

Walker teaches a method and corresponding system for establishing functions that affect credit card account and transactions comprising receiving an acceptance of an incentive offer, wherein the first amount is based on the incentive offer (col.3, line 43 to col.4, line 67 and col.15, line 60 to col.16, line 63); offering an incentive based on receipt of the application (col.3, line 43 to col.4, line 67 and col.15, line 60 to col.16, line 63); offering an incentive based on an approval of the application (col.3, line 43 to col.4, line 67 and col.15, line 60 to col.16, line 63); authorization includes a proxy agreement and wherein the first amount is undetermined at the time of the authorization (col.3, line 43 to col.4, line 67 and col.15, line 60 to col.16, line 63—determined by issuing institution and may be undetermined for a time); the second amount is equal to the first amount minus an incentive amount; the second amount is equal to the first amount less an incentive amount; the transaction is a product return transaction (col.3, line 43 to col.4, line 67 and col.15, line 60 to col.16, line 63—may be any type of transaction); and offering a seller an incentive amount (col.3, line 43 to col.4, line 67 and col.15, line 60 to col.16, line 63—incentive may be offered to customer or seller). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate receiving an acceptance of an incentive offer, wherein the first amount is based on the incentive offer; offering an incentive based on receipt of the application; offering an incentive based on an approval of the application; authorization includes a proxy agreement and wherein the first amount is undetermined at the time of the authorization; the second amount is equal to the first amount minus an incentive amount; the second amount is equal to the first amount less an incentive amount; the

transaction is a product return transaction; or offering a seller an incentive amount, as taught by Walker into the invention disclosed by Jagadish, to provide incentive for potential applicants.

***Response to Arguments***

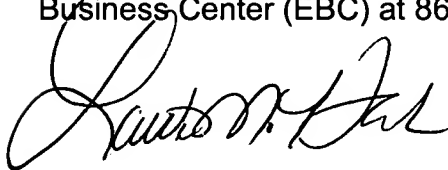
Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH